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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,996	01/23/2004	John Ravenstein		8226

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Stephen E. Feldman, P.C.
12 East 41st Street
New York, NY 10017

03/18/2009

EXAMINER

BROWN, ALVIN L

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

03/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,996

Applicant(s)

RAVENSTEIN, JOHN

Examiner

ALVIN L. BROWN

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a non-final, First Office Action on the merits. Claims 1- 20 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The claims 1 and 13 limitation "means for ornamentation" uses the phrase "means for" or "step for", but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase "means for" or "step for" is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant **does not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for" or "step for").

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-6, 9-12, 14, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over West et al., (20020133431) in view of Chapman et al., (20030135410).**

As per claims 1, 14 and 18, West discloses a method for selling jewelry comprising the steps of: providing a collection of jewelry having a defined style and

including means for ornamentation (paragraph [0026]); and selecting a piece of jewelry from the means for ornamentation and tailoring the selected piece of jewelry (paragraph [0035]).

West does not explicitly disclose developing a first advertising theme, the advertising theme tying the style of the collection of jewelry with a first geographically defined region; developing a second advertising theme, the second advertising theme identifying means for ornamentation with a second and smaller geographically defined region within the first geographically defined region.

However, Chapman discloses developing a first advertising theme, the advertising theme tying the style of the collection of jewelry with a first geographically defined region; developing a second advertising theme, the second advertising theme identifying means for ornamentation with a second and smaller geographically defined region within the first geographically defined region (paragraph [0032]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Chapman's geographically defined advertisements to West's collection of jewelry. One would be motivated to do this in order to improve the targeting of advertisement to segments of the population.

As per claim 2, West further discloses the step of providing further includes a plurality of jewelry selections in each collection of jewelry, the second theme of advertising being developed for the plurality of selections of jewelry, each selection of jewelry having a style that defines a variation on the style of the jewelry collection, the

second theme of advertising being variation on the theme of advertising of the jewelry collection (paragraph [0026]).

As per claim 3, West further discloses the step of providing includes indicia defining the theme of the collection of jewelry (paragraph [0026]).

As per claim 4, West further discloses the step of selecting includes selecting at least one precious stone for mounting in the selected piece of jewelry (paragraph [0003]).

As per claim 5, West further discloses the step of selecting includes selecting at least one accent stone for mounting in the selected piece of jewelry (paragraph [0003]).

As per claim 6, Chapman further discloses the step of developing includes selecting a geographically defined entity and defining a theme of heritage for one collection of jewelry associated with the geographic entity (paragraph [0017]).

As per claim 9, Chapman further discloses developing a second advertising theme for the selection of jewelry further includes developing the secondary advertising theme to define the second geographically defined region as a site within in the first geographically defined region (paragraph [0017]).

As per claims 10, 16 and 19, Chapman further discloses the secondary advertising theme includes identifying the selection of jewelry in honor of at least one of a city, a man made feature, or a natural geographic feature within a State (paragraph [0017]).

As per claims 11, 17 and 20, West further discloses providing includes providing a collection of jewelry having an art deco style (abstract).

As per claim 12, West further discloses the step of providing includes means for ornamentation primarily made from one or more precious metals (paragraph [0003]).

7. Claims 7-8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over West et al., (20020133431) in view of Chapman et al., (20030135410) further in view of Lefkowitz (20010037250).

As per claims 7 and 15, the West and Chapman combination does not explicitly disclose the step of developing a first advertising theme further includes relating the advertising theme to a State, the State being a State within the United States of America.

However, Lefkowitz discloses developing a first advertising theme further includes relating the advertising theme to a State, the State being a State within the United States of America (paragraph [0010, 0013]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Lefkowitz's advertisement theme to the combination's collection of jewelry. One would be motivated to do this in order to improve the targeting of advertisement to segments of the population of a particular State.

As per claim 8, Lefkowitz further discloses developing a first advertising theme further includes relating the heritage of the target population with the collection of jewelry (paragraph [0058]).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over West et al., (20020133431) in view of Chapman et al., (20030135410) further in view of Luciano et al., (20020094871).

As per claim 13, the West and Chapman combination does not explicitly disclose the step of providing includes means for ornamentation made at least partially of platinum.

However, Liciano discloses at least jewelry made with platinum (paragraph [0065]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Liciano's jewelry made with platinum to the combination's collection of jewelry. One would be motivated to do this in order to increase the chose in the collection of jewelry.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571 272 6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALB

/Arthur Duran/
Primary Examiner, Art Unit 3622